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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,989	12/11/2001	Yuji Ohtsu	F-7250	6776
28107	7590	03/05/2004	EXAMINER	
JORDAN AND HAMBURG LLP			ASHBURN, STEVEN L	
122 EAST 42ND STREET				
SUITE 4000			ART UNIT	PAPER NUMBER
NEW YORK, NY 10168			3714	6
DATE MAILED: 03/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

18

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/009,989	OHTSU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 December 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

***DETAILED ACTION******Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett, US 6,089,977 (Jul. 18, 2000).

Bennett discloses a slot machine including a special feature which is invoked when a special triggering combination of symbols occurs. *See abstract.* Once the special feature is triggered a wild symbol moves around the screen progressively replacing each symbol in the display. *See id.* As shown below, Bennett teaches all the features of the listed claims.

Claims 1, 11-15: Bennett teaches the following claimed features:

- a. A display unit for displaying a game screen, a input unit for executing a predetermined game on the screen of the display unit with reference to an output signal from the input unit. *See fig. 1; col. 1:60-2:14; 2:52-65.*
- b. The game controller comprising a selection device for selecting a predetermined number of symbols to be displayed on the game screen from a predetermined selection candidate group; a dividend controlling device which controls a dividend for a player based on the combination of selected symbols. *See id.*
- c. The game controller further comprising a probability controlling device which controls a probability of a dividend by adding or removing at least one common symbol which can be used as a plurality of symbols from the candidate group according to the outcome of the game. *See col. 2:15-29; 3:65-67.* In particular, the examiner interprets the “candidate group” to mean the

group of symbols comprising an activated payline. The processor used in Bennett controls the probability of a payout dividend by adding and removing a wild symbol that combines with each of the symbols of the candidate group.

Claim 2: Bennett discloses the probability controlling device that adds the common symbol to the selection group when the outcome of the game satisfies a predetermined condition. *See id.*

Claim 3: Bennett discloses the probability controlling device judging that the condition has been satisfied and adds the common symbol. *See id.*

Claim 4: Bennett discloses a condition controlling device that increases the number of probability fluctuating hands according to the value of the play that the player sets is greater. *See col. 2:66-3:1.* In particular, Bennett allows players to increase the number of paylines based on the value wagered by the player.

Claim 5: Bennett discloses the probability controlling device removing at least one common symbol from the selection candidate group when the outcome of the game satisfies a predetermined finish condition after the common symbol is added to the selection candidate group. *See 4:44-46; 5:52-56.* In particular, the examiner interprets the displayed paylines as the selection candidate group. After the bonus symbol satisfies the predetermined condition of reaching the end of the displayed group, it is removed from the displayed paylines.

Claim 6: Bennett discloses the probability controlling device judging that the finish condition is satisfied when the dividend controlling device produces a predetermined divided and removes the symbol.

Art Unit: 3714

*See id.* In particular, when the bonus symbol reaches the end of the display, the game pays out the predetermined award for the resulting combination of symbols.

Claim 8: Bennett discloses the probability selecting device selecting the respective symbols from the selection candidate group is evenly set in the respective symbols. *See col. 1:54-58.* In particular, the bonus symbol selects symbols from the candidate equally because it selects every symbol in the group.

Claim 9: Bennett discloses using trump cards as symbols and the dividend controlling device producing a dividend when a predetermined lucky hand is formed by the combination of selected symbols on the card game using the trump cards. *See 3:36-38; 5:53-56.* In particular, the examiner interprets the applicant's use of the term "trump symbols" to mean "special symbols". Bennett provides a payoff with the bonus symbol when special symbols occur in a particular manner in the display forming a "lucky hand".

Claim 10: Bennett discloses the probability selecting device adding a penguin as the common symbol. *See col. 3:46-56.* The penguin symbol is equivalent to a joker symbol.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Adams, US 5,431,408 (Jul. 11, 1995).

Bennett discloses all the features of the claim except changing a symbol according to an instruction by the player through an input unit. Adams discloses an analogous gaming device wherein a player is given the option of preserving a wild card and later, when a new hand of symbols will provide a particular high payout, changing a symbol to a wild card according to an instruction by the player through an input unit. *See fig.2(32); col. 1:53-2:19.* In view of Adams, it would be obvious to an artisan to modify Bennett, wherein a player receives a wild card, to allow the player to change a symbol according to an instruction by the player through an input unit. As suggested by Adams, the modification would enhance the player's enjoyment of the gaming device by allowing the player to maximize the impact of receiving a wild card. *See col. 1:53-67.*

***Prior Art, Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- a. US 2003/0027628 discloses a gaming device allowing substitution of a wild symbol.
- b. WO 97-31344 discloses a gaming device allowing substitution of a wild symbol.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER  
PRIMARY EXAMINER